

UNITED STATES DISTRICT COURT  
Northern District of California

NUANCE COMMUNICATIONS, INC.,

Plaintiff(s),

v.

ECOPY, INC.,

Defendant(s).

No. C 08-4227 JSW (MEJ)  
Consolidated with C 08-4942 JSW (MEJ)

**ORDER RE: JOINT DISCOVERY  
DISPUTE LETTER (DKT. #144)**

**I. INTRODUCTION**

Now before the Court is the joint discovery dispute letter (“Joint Letter”) filed by Plaintiff Nuance Communications, Inc. (“Plaintiff”) and Defendant I.R.I.S. (“Defendant”) on March 11, 2010. (Dkt. #144.) Upon consideration of the contentions in the Joint Letter, the Court ORDERS the following.

**II. BACKGROUND**

At the December 18, 2009 case management conference before the Honorable Judge White, the presiding judge in the matter, the Court stated: “I am going to order you to come back with a proposal, or dueling proposals, of a way to slim this case down.” (RT 18:3-5, Dkt. #132.) The Court further stated: “I want you to come back having met and conferred on a way to narrow down the claims that are initially adjudicated.” *Id.* at 22:18-20. The Court continued: “I think that’s a fair point, and I think you can’t have meaningful discussions about possible limitations—it’s kind of the proverbial pig in a poke here—until that process is completed.” *Id.* at 15:20-23. The Court went on to say: “What if we complete that process with respect for the initial phases, the next phases of the case, what about that?” *Id.* at 15:24-25.

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### III. DISCUSSION

Plaintiff argues that it is entitled to fifty-five claim charts beyond the ones already supplied by Defendant. (Joint Letter at 1.) Plaintiff argues that Defendant identified over seventy prior art references, and argues that Defendant must disclose claim charts for each. *Id.* Plaintiff seeks an order compelling Defendant to provide a chart for each cited prior art. *Id.* at 3.

In response, Defendant argues that it has provided invalidity contentions on all nine patents-in-suit and provided Plaintiff with twenty-three claim charts, representing “the best presently-known prior art for each patent and claim; and provided at least one claim chart invalidating each and every one of them. . . .” *Id.* Defendant argue that being required to provide additional claim charts for each item of prior art is excessive in light of Judge White’s intention to slim down the case. *Id.*

The Court finds that Defendant’s willingness to let its invalidity case stand or fall on the twenty-three charts already produced advances Judge White’s directive to “slim this case down.” Accordingly, the Court ORDERS the parties to file a joint stipulation and proposed order memorializing Defendant’s offer.

Additionally, it is unclear to the Court why Plaintiff waited until March 11, 2010 to raise the issue of where the non-infringement documentation would be produced. However, Plaintiff’s offer to “pay for a server and necessary hardware onto which the source code could be copied and maintained at the office of [Plaintiff’s] U.S. outside counsel[,]” is well-taken. Plaintiff argues that this would enable Defendant to control access to the source code, and would save Plaintiff and its experts from having to travel to a foreign country each time Defendant sought to review the source code.<sup>1</sup> The Court finds this reasonable. The parties are hereby ORDERED to meet and confer to finalize the terms of a protective order which will address Defendant’s concerns over control of the source code.

### IV. CONCLUSION

The parties are hereby ORDERED to submit a joint stipulation and proposed order

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<sup>1</sup>See *Fortera Systems, Inc. v. Avatar Factory*, 2006 WL 2458804, at \*2, where a similar plan was implemented.

1 memorializing Defendant's offer within seven days following the issuance of this Order. The parties  
2 are further ORDERED to meet and confer within two weeks regarding the substance of the above-  
3 mentioned protective order and to file the stipulated protective order within three weeks following  
4 the issuance of this Order.

5 **IT IS SO ORDERED.**

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7 Dated: April 1, 2010

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10 Maria-Fern Jones  
11 Chief United States Magistrate Judge  
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